

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of this response, Claims 1-17 will be all the claims pending in the application. Instantly, Claims 1-7 are amended claims and Claims 8-17 are newly added. Broadly, the claims now recite, *inter alia*, "an iron oxide/iron oxyhydroxide-containing aminomethylated polystyrene ion exchanger...", "wherein said iron oxide/iron oxyhydroxide-containing aminomethylated polystyrene ion exchanger is a non-carboxyl bearing ion exchanger." Applicants submit that it is for the inventor to decide what bounds of protection he will seek and he has the right to retreat to otherwise patentable subject matter because only part of what was originally claimed is patentable. In re Johnson, 194 USPQ 187, 195-96 (CCPA 1977). Moreover, Applicants respectfully submit no new matter has been added by the present amendments. Support for these amendments can be found generally throughout the text of Applicants' disclosure and, more specifically, at Page 3, Lines 21-23. It should also be noted these amendments are not in acquiescence of the Office's position on the allowability of the claims, but made instead to expedite prosecution.

The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

I. Objections to the Claims

The word "preferably" complained of by the Office as used in Claims 3 and 4 has been deleted. Therefore, the objection is now moot and can be withdrawn.

II. Claim RejectionsA. 35 U.S.C. 112 and 101

Claims 3, 5, and 7 stand rejected under 35 U.S.C. 112 and 101. Claims 3, 5, and 7 have been amended to clearly set forth process steps. In light of these amendments the Applicants submit these rejections can be properly withdrawn.

With respect to Claim 2, the amended claim now recites, "formed by" rather than "obtainable." Applicants are unclear as to the exact nature of the Office's outstanding complaint with respect to Claim 2; however, Applicants respectfully submit that amended Claim 2 sets forth the metes and bounds of the claimed invention so as to fully comply with the statutory requirements and, therefore, requests the withdrawal of said rejection. In the unlikely event the rejection is not withdrawn Applicants request further clarification as to the full nature of the rejection.

B. 35 U.S.C. 102(b) Rejection over Karlou-Eyrisch et al. and Hosoda et al.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Karlou-Eyrisch et al., U.S. Patent Application Publication No. 09/903,006, hereinafter "Karlou-Eyrisch". Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by Hosoda et al., Japanese Patent Application No. JP 09-225298, hereinafter "Hosoda."

As the Examiner correctly states, "Karlou-Eyrisch discloses [...] a process for preparing crosslinked bead polymers, which is characterized in that a monomer mixture of hydrophilic (meth)acrylate, amino (meth)acrylate, crosslinker and, where appropriate, other monomer is polymerized to beads by inverse suspension polymerization, and the latter are then doped with superparamagnetic iron oxide by an after-treatment with iron

salt solution' (page 2, [0024])." (*Office Action, Pgs. 3-4*) (*Office's emphasis is not shown.*)

In contrast to Karlou-Eyrisch, the present invention relates to a polystyrene material based ion exchanger, rather than Karlou-Eyrish's relation to only (meth)acrylate based ion exchangers, in which it is explained (meth)acrylate shall mean "the derivatives of acrylic acid and methacrylic acid." (*Karlou-Eyrisch [0013]*) Moreover, Karlou-Eyrisch fails to contemplate the possible use of another material.

With respect to the Hosoda reference, Hosoda appears to relate to iron and hydroxyl ions supported on a cation exchange resin or chelate resin. (*Hosoda [008]*) Hosoda provides a process for the recovery of arsenic from an arsenic-containing solution wherein the solution is contacted with the arsenic-adsorbing resin comprising a cation exchange resin and/or chelate resin on which is supported iron and hydroxyl ions. (*Id.*) However, Hosoda fails to teach, *inter alia*, an iron oxide/iron oxyhydroxide-containing aminomethylated polystyrene. The chelating resin taught by Hosoda appears to be two functional chelating groups on a resin matrix. (*Hosoda [0012]*) While the chelating functional groups disclosed in Hosoda include amines, the resin matrix used for such chelating ion exchangers fails to include styrene. Instead Hosoda teaches the use of the copolymer poly[styrene-co-(divinyl benzene)] for its chelating ion exchangers. (*Id.*) Furthermore, where Hosoda does appear to teach the use of a styrene resin matrix, the teaching is strictly limited to the use of the styrene matrix in combination with a cation exchanger. Because it is generally understood by those skilled in the art that a cation exchanger does not include an amine based resin, there is simply no teaching of an aminomethylated polystyrene ion exchanger.

Since the references cited fail to teach all of the presently claimed limitations of the invention they fail to anticipate the invention. At the very least, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under

construction." *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1554 (Fed. Cir. 1983); see also *In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

For the aforementioned reasons, Applicants respectfully request the withdrawal of the present 35 U.S.C. 102(b) rejections.

C. Double Patenting Rejection Under 35 U.S.C. 101

Applicants acknowledge the instant statutory-type double patenting ("SDP") rejection in view of Applicants' co-pending application (Serial Number 11/299,098). Applicants respectfully submit that the present application is presently in condition for allowance. As the Examiner is assuredly aware, "If a 'provisional' statutory double patenting rejection is the only rejection remaining in one of the applications (but not both), the examiner should withdraw the rejection in that application and permit that application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application into a double patenting rejection when the application issues as a patent." (*MPEP 804(I)(B)(2)*) In the unlikely event the present application is not found to be in condition for immediate allowance, Applicants hereby reserve the right to respond as necessary to fully satisfy the requirements for the withdrawal of the SDP rejection.

III. Conclusion

In view of the foregoing, it is respectfully submitted that the instant application, including Claims 1-17, is presently in condition for allowance. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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